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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,807	01/07/2004	Charles Whitlow	22890-RA	5123
30184	7590	02/15/2005	EXAMINER	
MYERS & KAPLAN, INTELLECTUAL PROPERTY LAW, L.L.C.			SUHOL, DMITRY	
1899 POWERS FERRY ROAD			ART UNIT	
SUITE 310			PAPER NUMBER	
ATLANTA, GA 30339			3714	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,807

Applicant(s)

WHITLOW, CHARLES

Examiner

Dmitry Suhol

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 28a, 42, 54a-54e, 62a-62b, 62c-62d, 62k-62l. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Art Unit: 3714

The application has two claims numbered 17. The second claim 17 and claims 18-19 have been renumbered claims 18-20 respectively.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "the stored contents".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-9, 12-14, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Macken '729. Macken discloses a combination themed storage and display device containing all of the elements of the claims including with reference to claim 1, an openable container defined by a plurality of walls (figures 1 and 2), a base (16), a top (10), an interior compartment defined by the base and walls (interior of device shown in figure 2), a plurality of display frames defined in the plurality of walls

Art Unit: 3714

(considered to be the gaps formed between sidewalls of boxes 13 and 14), the container having a three-dimensional configuration (figure 2) thematically related to stored contents (col. 2, lines 35-37). The top being removable, as required by claim 2, is shown in figure 1 and further described at col. 2, lines 32-33. The three-dimensional configuration being in the form of a school building, as required by claim 4, is shown in figure 1, where it is considered that lacking any distinguishing features a school building could have a cubic or rectangular shape/form. A plurality of display frames being a plurality of windows of the school building, as required by claim 5, is read onto the frames formed from boxes 13 and 14, where it is considered that since boxes 13 and 14 can be transparent (col. 1, lines 22-29) the frames fit the term windows. A top being a roof (lacking any further distinguishing features), as required by claim 6, is read onto top 10. The plurality of display frames being suitable for receipt and sequential display of annual school photographs, as required by claim 7, is inherent in the device since col. 2, lines 44-46 clearly state that the device may display photographs. An interior storage compartment having ornamentation, as required by claim 8, is read onto the stored ornaments described at col. 2, lines 8-11. Ornamentation being a school component, as required by claim 9, is described at col. 2, line 10, where a paperclip is commonly known to be used in a school environment. The three-dimensional configuration being in the form of a sports arena, as required by claim 14, is shown in figure 1, where it is considered that lacking any distinguishing features a sports arena could have a cubic or rectangular shape/form. Windows carrying a transparent covering, as required by claim 16, is read onto the transparent box 14.

Regarding claims 12 and 13, lacking any distinguishing features, a school mascot emblem, as required by claim 12, and a school color scheme, as required by claim 13, are read onto the design theme (11) and its associated colors described at col. 2, lines 35-37. However it should further be noted that it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of decoration does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. school mascot emblem and a school color scheme) and the substrate (e.g. display device) which is required for patentability.

Claims 1-2, 4-10, 12-15, 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelley '165. Kelley discloses a themed device containing all of the elements of the claims including with reference to claim 1, an openable container defined by a plurality of walls (figure 1, walls 100, 200, 300 and 400), a base (110), a top (700), an interior compartment defined by the base and walls (interior of the structure shown in figures 1-2), a plurality of display frames defined in the plurality of walls (considered to be the frame of window 210 and frame formed by the opening in wall 200 shown in figure 1), the container having a three-dimensional configuration

Art Unit: 3714

(figures 1-2) thematically related to stored contents (see abstract). The top being removable, as required by claim 2, is described at col. 4, lines 49-52 and col. 5, lines 22-24. The three-dimensional configuration being in the form of a school building, as required by claim 4, is shown in figure 1. A plurality of display frames being a plurality of windows of the school building, as required by claim 5, is shown in figures 1 and 2. A top being a roof, as required by claim 6, is shown as top 700 in figure 1. The plurality of display frames being suitable for receipt and sequential display of annual school photographs, as required by claim 7, is inherent in the device since (lacking any distinguishing features) photographs may be easily displayed on the window frames as desired. An interior storage compartment having ornamentation, as required by claim 8, is shown in figure 7A and described at col. 3, lines 46-65. Ornamentation being a school component, as required by claim 9, is also described at col. 3, lines 46-65. Ornamentation being a chalkboard, as required by claim 10, is shown as element 425. The three-dimensional configuration being in the form of a sports arena, as required by claim 14, is described in the abstract where a gym and swimming pool are considered to be sports arenas. A door, as required by claim 15, is shown as door 600. Lacking any distinguishing features, a hanging file-type apparatus, as required by claim 17, is read onto elements 333 since they hang and may be used to store a variety of different items. A locking mechanism, as required by claim 18, is read onto the locking mechanism described at col. 5, lines 9-16.

Regarding claims 12 and 13, lacking any distinguishing features, a school mascot emblem, as required by claim 12, and a school color scheme, as required by

Art Unit: 3714

claim 13, are read onto the colors utilized in the structure and any one of the symbols 525. However it should further be noted that it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of decoration does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. school mascot emblem and a school color scheme) and the substrate (e.g. display device) which is required for patentability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Macken '729 in view of Miki et al '663. Although Macken discloses all of the elements of the

Art Unit: 3714

claims, as stated above, the reference fails to explicitly teach a top being hingedly related to at least one of the peripheral walls as required by claim 3. However, Miki discloses a display device which teaches that it is known to provide such a device with a top (22) that is hingedly related to a peripheral wall (figure 11). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, provide the device of Macken with a lid and related wall construction incorporating a hinge type relationship for the purpose of allowing components held with the device of Macken to be easily and readily replaced while keeping the top secured to the box to prevent loss thereof.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley '165. Although Kelley discloses all of the elements of the claims, as stated above, and further including a clock ornamentation as required by claim 11, the reference fails to teach that the clock is located within the interior storage compartment. However, it would have been obvious to place the clock ornamentation within the interior compartment to make it more accessible to the user and since it has been held that rearranging of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macken '729. Although Macken discloses most of the elements of the claims, as stated above, including all of the structural features claimed in claim 19 and 20, the reference

Art Unit: 3714

fails to disclose a locking mechanism as required by claim 18 and explicit teaching of method steps of opening the top, placing themed memorabilia into the interior compartment, inserting the photographic memorabilia into the plurality of frames and replacing the top of the display device as required by claim 19.

Regarding claim 18, it would have been obvious to incorporate a locking mechanism in the device of Macken for the purpose of preventing unwanted removal of articles or photographs since the examiner takes official notice that locking mechanisms are well known to be utilized in display and storage arts for the above purpose.

Regarding claim 19, the method steps of opening the top, placing themed memorabilia into the interior compartment, inserting the photographic memorabilia into the plurality of frames and replacing the top of the display device would have all been obvious in order to utilize the device of Macken as intended.

Conclusion

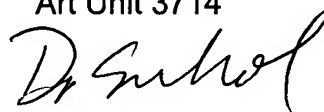
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dmitry Suhol
Examiner
Art Unit 3714



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